

REMARKS/ARGUMENTS

The Office Action dated June 6, 2003 has been carefully reviewed. Claims 1-20 and 22 are pending in the application. Claims 1-14, 20 and 22 are rejected. Claims 15-19 are withdrawn from consideration as being drawn to a non-elected invention. This rejection has been made FINAL.

The Examiner has indicated that claim 19 stands withdrawn from consideration along with claims 15-18 because claim 19 was amended to be dependent from claim 15 which had been previously withdrawn from consideration. By the present amendment claim 19 has been amended to be dependent from claim 1. A closer comparison of claims 2 and 19 revealed that the claims, although similar, are not identical. The Examiner is requested, therefore, to reconsider the withdrawal of claim 19.

The Examiner has indicated that in the previous Office Action the provisional application was found to fail to provide adequate support for claims 1-14 of the present application. Applicants wish to point out that in the previous Office Action the Examiner based this conclusion on the belief that the provisional application did not disclose the sulfonamido substituents to be at the 2-position of the benzoindole ring but rather are N-substituted to the benzoindole ring. In their response applicants pointed out that compounds wherein the sulfonamido group is positioned at the 2-position as well as compounds wherein the sulfonamido group is N-substituted are described and prepared in the provisional application. Compounds wherein the sulfonamido group is at the 2-position of the benzoindole ring are described and prepared in scheme 3 on page 30 of the provisional application. In addition, applicants pointed out that compounds wherein the sulfonamido group is at the 2-position of the benzoindole ring were specifically claimed in claims 15 and 17 of the provisional application.

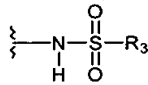
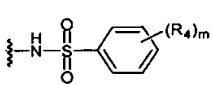
In maintaining that applicants' claims are not entitled to priority, the Examiner now refers to scheme 4 on page 30 of the priority application and concludes that formula XIV has a much narrower scope than formula A of the present application, that formula A has variables B₁, B₂, R₂, Y and Z and concludes that these variables are not described in scheme 4 or in claims 15 and 17 of the provisional application. Applicants wish to point out that in scheme 4 the variables B₁, B₂ and R₂ are obviously hydrogen, Y is methylene (-CH₂-) and Z is N-(phenyl)sulfonamido or -NHSO₂R₃. In generic claim 1 the variables B₁, B₂ and R₂ can be hydrogen, Y can be methylene and Z is as defined. Z in scheme 4 is obviously N-(phenyl)sulfonamido (compound XIII) or -NHSO₂R₃ (compound XIV). (See the definition of B₁, B₂, R₂, Y and Z in the description on pages 6-10 of the provisional application.) Applicants also wish to point out that on page 37, lines 29-33, of the provisional application a method is described for preparing those compounds wherein B₂ and R₂ are other than hydrogen.

The Examiner then goes on to state that in claim 4 of the present application Z is -N-(phenyl)sulfonamido while in claim 15 the "corresponding R₃" is defined as cycloalkyl, naphthyl or heteroaryl but not phenyl. The Examiner then concludes that

"Because the subgenus of the provisional application does not provide support for the entire genus of the present application, claims 1-14 are not entitled to the priority filing date".

Applicants wish to point out that the phenyl ring in the -N-(phenyl)sulfonamido group in claim 4 does not correspond to R_3 in claim 15 as indicated by the Examiner. Claim 4 claims seven specific compounds in each of which Z is a phenylsulfonamido group. Although there is no phenyl group in the definition of R_3 , it should be pointed out that R_3 is never phenyl in the definition of Z in the generic structure. Therefore, the fact that a phenyl group does not appear in the definition of R_3 is of no consequence. The -NHSO₂ R_3 group in scheme 4 and in claims 15 and 17 is merely one definition of Z.

In claim 1 in both applications B_1 is defined as hydrogen; B_2 is defined as hydrogen, C_{1-5} alkyl or substituted C_{1-5} alkyl; R_2 is defined as hydrogen, C_{1-5} alkyl or substituted C_{1-5} alkyl; Y is defined as methylene (-CH₂-) or carbonyl (C=O) and Z is

defined as  (N-sulfonamido) and  (N-(aryl)sulfonamido) among other things, wherein R_3 is defined as alkyl, cycloalkyl, naphthyl or heteroaryl and R_4 is defined as alkyl, alkoxy, hydroxy, halo, cyano, nitro, amino, and alkylamino. Schemes 3 and 4 were never intended to illustrate a method for preparing all of the compounds encompassed by the generic claim. As indicated on page 29 of each specification scheme 3 illustrates a method of preparing those compounds of formula A in which Y equals methylene. Scheme 4 illustrates a method of preparing the amines (XIII) and (XIV) from the regiomeric amides (IX) and (X) prepared in scheme 3. It should be readily apparent that in schemes 3 and 4 B_1 , B_2 and R_2 are each hydrogen and Y is methylene while Z is either -N-phenylsulfonamido or -NHSO₂ R_3 .

It is submitted that the generic disclosure in the non-provisional application is fully supported by the generic disclosure in the provisional application. Compounds wherein the -N-phenyl(sulfonamido) group is in the 2-position are disclosed generically in both the provisional and the non-provisional applications. Claims 15 and 17 are merely illustrative of certain compounds wherein the sulfonamido group is at the 2-position. Claims 15 and 17 are supported by the generic disclosure in claim 1 in both applications. As indicated above, R_3 in claim 15 does not correspond to the phenyl group in the definition of Z, as stated by the Examiner. This being the case, it is submitted that the disclosure in the provisional application clearly provides support for the entire genus of the present application. Applicants, therefore, are entitled to the priority filing date of the provisional application.

Claims 1-14, 20 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by McNally *et al.* The publication date of the McNally reference is March 7, 2000. Applicants' filing date is April 20, 2000; however, applicants' effective filing date is May 5, 1999. Since applicants' effective filing date is prior to the publication date of the reference, it is submitted that applicants' invention is not anticipated by McNally *et al.*

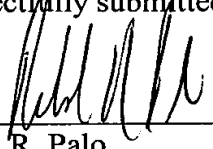
Reconsideration of the rejection of claims 1-14, 20 and 22 under 35 U.S.C. 102(a) as being anticipated by McNally *et al.* is courteously requested.

Applicants take note of the fact that the rejection of claims 1, 2, and 20-22 under 35 U.S.C. 112, first paragraph, and that the rejection of claims 2, 20 and 21 under 35 U.S.C. 112, second paragraph, are hereby withdrawn.

Applicants also take note of the fact that the restriction requirement has been made FINAL.

In view of the above discussion and the amendments herein being made to the claims, it is believed that all of the outstanding objections and rejections have been removed. Applicants respectfully request that a timely Notice of Allowance be issued in this application. In the event that the Examiner adheres to the Final Rejection, entry of the amendment is requested in order to make the record on appeal complete.

Respectfully submitted



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DATE: November 20, 2003